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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/02/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,589

Applicant(s)

PICARD-LESBOUEYRIES ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on April 15, 2002 in Paper No. 7 wherein claims 1-22 have been amended and claims 23-29 are newly submitted. Currently, claims 1-29 are pending in this application.

Applicant's amendment filed on April 15, 2002 in Paper No. 7 with respect to the rejection of claims 1-22 made under 35 U.S.C. 112 second paragraph for the use of the indefinite expressions, i.e., "type" in claims 1, of record stated in the Office Action dated January 15, 2002 have been fully considered and found persuasive to remove the rejection since the term "type" has been removed from the claims.

Claim Objection

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim for reasons of record stated in the Office Action dated January 15, 2002. Applicant's remarks filed on April 15, 2002 in Paper No. 7 have been considered but not found persuasive since "a modulus....." in claim 3 is an inherent property of the composition herein, as discussed in the previous Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1617

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahms et al. (5,911,981) and Erilli et al. (5,629,279) and Ribier et al. (5,601,833) essentially for reasons of record stated in the Office Action dated January 15, 2002.

Dahms et al. discloses a stable foaming composition in an aqueous medium comprising a surfactant system generating paracrystallin phase such as direct hexagonal phase for cleaning skin or hair including removing a greasy soil from skin or hair (see abstract, col.1 lines 5-16, col.2 lines 8-15 and 18-20, fig. 2, col.3 lines 6-13 and 63-66, col.10 lines 34-35, 45, 54-55 and col.13 lines 35-36). Dahms et al. also discloses that the surfactant system comprises one water-insoluble surfactant in about 75% weight (nonionic or amphoteric) and water soluble anionic surfactants, acyl lactylate (0.1-25% weight) and a sulfated anionic surfactant (see the structural formula at col. 3 lines 40-49, col.4 line 64, col.8 lines 55-60, and claims 1-16).

Erilli et al. discloses a stable foaming composition in an aqueous medium for cleaning skin comprising a surfactant system which comprises water-insoluble surfactants (nonionic or amphoteric) and water soluble surfactants (10-30% or 1-10% weight) within the instant claims. Erilli et al. also discloses that the active agents therein range from 0.5% to 5%. See abstract, col.2-8 and claims 1-9.

Ribier et al. discloses that a composition for the simultaneous treatment of skin such as protecting and nourishing including removing fatty substance in the skin

Art Unit: 1617

comprises water-soluble surfactants, water-insoluble surfactants, and active agents such as anti-oxygenated-free-radical agents and vitamins. See abstract, col.1 line22, col3 lines 50-51, col.4 lines 10-22, col.7 and claims 1-17.

The prior art does not expressly disclose that the employment of a surfactant system herein in combination with an active agent here in a composition and a method for cleaning greasy skin and or acne skin. The prior art does also not expressly disclose that the surfactant system is stable at up to 45⁰C. The prior art does also not expressly disclose the particular range of amounts of surfactants herein in the composition.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ a surfactant system herein in combination with an active agent here in a composition and a method for cleaning greasy skin and/or acne skin, and to optimize the surfactant system to be stable at up to 45⁰C, and to optimize the particular range of amounts of surfactants herein in the composition.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ a surfactant system herein in combination with an active agent here in a composition and a method for cleaning greasy skin and or acne skin since adding active agents herein such as salicylic acid to a foaming composition for cleaning skin is well known in the art. Moreover, the surfactant systems in the compositions of Dahms and Erilli are known to be useful in cleaning greasy skin. Therefore, one of ordinary skill in the art would have reasonably expected that combining the surfactant system of Dahms or Erilli and an active agent known useful for the same purpose (i.e., cleaning or treating skin) in a composition to be administered

Art Unit: 1617

would improve the therapeutic effect for cleaning/treating skin. Further, the teachings of Ribier et al. provide the motivation for the combination herein.

Since all composition components herein are known to be useful to treat skin, it is considered *prima facie* obvious to combine them into a single composition to form a third composition useful for the very same purpose. At least additive therapeutic effects would have been reasonably expected. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Additionally, one of ordinary skill in the art would have been motivated to optimize the surfactant system to be stable at up to 45°C, and to optimize the particular range of amounts of surfactants herein in the composition because optimization of amounts of ingredients and their inherent properties is considered well within the skill of artisan, involving merely routine skill in the art.

Thus the claimed invention as a whole is clearly *prima facie* obvious over the combined teachings of the prior art.

Applicant's remarks filed on April 15, 2002 in Paper No. 7 with respect to this rejection of claims 1-22 made under 35 U.S.C. 103(a) of record stated in the previous Office Action (January 15, 2002) have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant's arguments that Dahms neither teaches nor suggests surfactant having the claimed paracrystalline phase, nor does teach or suggest thermally

Art Unit: 1617

stabilizing foaming cream compositions with such a surfactant system, are not found convincing. Dahms et al. clearly discloses a stable foaming composition in an aqueous medium comprising a surfactant system generating paracrystallin phase such as direct hexagonal phase for cleaning skin or hair including removing a greasy soil from skin or hair. Moreover, thermal stabilization is merely one of inherent properties of a composition herein, which is not considered a limitation to a composition, since it is well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition.

Applicant also argues that Erilli et al. neither teaches or suggests, nor recognizes the importance of incorporating the claimed surfactant systems into foaming cream compositions. However, the instant claims are limited to a composition in a cream form. Further, a composition in a cream form is well known in the art.

Applicant further argues that Ribier does not compensate for Dahms' and Erilli's deficiencies. However, as discussed in the set forth 103 rejection, the teachings of Ribier et al. provide the motivation for the combination herein.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

Applicant's data shown in the Examples 1-2 of the specification at pages 26-33 herein have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive for the reasons below. Examples herein provide no clear and convincing

Art Unit: 1617

evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present. Moreover, Examples herein merely demonstrate two particular compositions within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the ingredients in the claimed compositions. See MPEP § 716.02(d). Therefore, the evidence presented in specification herein is not seen to support the nonobviousness of the instant claimed invention over the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1617

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
June 20, 2002

RUSSELL TRAVZRS
PRIMARY EXAMINER
GROUP 1200